



IN THE
Supreme Court of the United States

OCTOBER TERM, 1944

No. 1251

THE WESTERN STATES MACHINE COMPANY,
Petitioner,

vs.

S. S. HEPWORTH COMPANY,
Respondent.

**RESPONDENTS BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

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May, 1945.



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**RESPONDENT'S BRIEF OPPOSING PETITION FOR
WRIT OF CERTIORARI.**

The petition does not present any question of conflict of opinion between Circuit Courts of Appeal nor any question of general or public importance. The suit is an ordinary one for alleged patent infringement decided adversely to the patents on orthodox principles well settled among the circuits and by this court.

OPINIONS BELOW.

The opinion of the Circuit Court of Appeals for the Second Circuit is reported in *147 Fed. (2) 345 (Adv. sheet #3)* and the opinion of the District is reported in *51 Fed. Sup. 859*. A supplemental opinion of the District Court is not reported but is printed in Volume A of the record, at page 64.

STATEMENT OF THE CASE.

The petition mentions three patents 1,758,901, (the Control Patent), 2,096,341 (the Brake Patent) and 2,145,633 (the Separator patent). Two other control patents were also involved in the suit; both were held not infringed and have been dropped.

Both infringement and validity of all patents were challenged.

The Control Patent.

Validity of this patent was attacked on the grounds of anticipation, of prior public use and of lack of invention. The Court of Appeals did not pass upon any of those grounds, except insofar as it found the prior control of the Carlson patent to require a limitation of the claims in suit if they were to have any validity. On that score the court said:

"This does not mean that we must hold the claims invalid for *all*¹ purposes. When a patentee has disclosed a meritorious invention, but has claimed it too broadly he is not always forced to a reissue; courts will at times read into the broad language limitations drawn from the specifications, which save the claims as they stand."

The implication plainly is that the court was faced with these alternatives: It could find the claims invalid because too broadly drawn, or it could read them as they might have been drawn and find them not infringed. The Court took the second alternative.

Then, as to the other defenses, the court took pains to say:

¹ Italics throughout the brief are supplied by respondent.

"We need not consider the Andrews & Newman patent, or any of the other references;² although we do not wish to be understood as holding that they too may not be a sufficient answer."

Hence the important question of validity would require this court's detailed consideration if there were sufficient reason to grant the writ to review the appellate court's findings of non-infringement.

The Control patent³ is based on an intricate assembly of devices including links, levers, gears and a timing mechanism of an odd and particular sort, for measuring the duration of the three periods of centrifugal operation (called purging, washing and drying periods) and to set the brake automatically. The controls of the patent in suit are entirely mechanical.

In contrast the accused controls⁴ are electrical, simply employing three common commercial electric time clocks to measure the duration of the purging, washing and drying periods.

The Carlson patent⁵ (whose system defendant employs)⁶ disclosed the use of electric time clocks to measure the duration of the purging and washing periods; and the prior patent to Andrews & Neuman⁷ disclosed a time clock to terminate the drying period and to set the brake for automatically stopping the machine. But the appellate court correctly held⁸ that (even without the dis-

² The several defenses relied on in the Court of Appeals are found in the "Statement of Points of Defendant-Appellant" (Vol. C, p. 563).

³ Rec. Vol. B, pp. 686, 754

⁴ Vol. B, pp. 786, 788, 790

⁵ Vol. B, p. 782

⁶ Vol. A, p. 37

⁷ Vol. D, p. 614; Vol. B, p. 776

⁸ Vol. E, p. 172

closure of Andrews and Neuman) the addition of a third time clock to Carlson's system, to carry automaticity beyond the purging and spraying periods, would be no warrant for allowing it to be the basis of a patent. Therefore the appellate court logically concluded as to the claims in suit:

"The only invention, which can support them at all, lies in the specific timing mechanism, together with its accompanying train of mechanical elements. To that defendant owes nothing; its whole system has a totally different structure and a totally different provenience." (Rec. Vol. E, p. 173.)

The case therefore does not involve, as Petitioner argues, an evasion of the patent by mere difference in form. The accused controls are, as the appellate court found, "a totally different structure" than the patented control.

But even if plaintiff's argument was accurate, the basis for review would be merely factual, which is insufficient by itself for grant of the writ.

The Brake Patent.

This patent⁹ is based on a brake cooling system, wherein water is let into a hollow rotating brake drum by an inlet pipe and any excess is scooped out by an offtake or scoop pipe as the drum rotates. Review is asked only as to claims 8 and 9.

Concurrent decisions below held claim 8 invalid over a public use at the Baltimore refinery of the American Sugar Refining Company. No sound reason appears why the petitioner should be accorded a third hearing on valid-

⁹ Vol. B, p. 694

ity of a claim twice held invalid in view of the same prior use structure.

Claim 9 differs from claim 8 by including as an additional element a valve in the inlet line of the cooling system, which is operated by the brake lever to shut off the flow when not desired, i. e. when the brake is operated to bring the machine to rest.

The accused structure¹⁰ has no valve. Its means for interrupting the operation of the liquid supply is totally different from the patent. The appellate court thereupon based its finding of non-infringement. The decision is manifestly sound and in arriving at it the court followed established principles. Although the court hinted that the claim may be invalid for lack of invention, the court specifically refused to pass on validity and did not affirm the district court on that ground, choosing instead the alternative of holding the claim limited to "a measurably similar mechanical train" to that shown in the specifications. As so construed, the court could only hold the claim not infringed.

Manifestly the decision was correct and supplies no ground whatsoever for the petitioner to seek review. Claim 9 was not "changed" by the appellate court. No element was read into or out of the claim, nor does the petitioner give any clue as to how the claim was "changed" other than to say it was limited too greatly. That is a matter of opinion.

The court read claim 9 in the only way it is proper to read a patent claim—in the light of the specification, against the background of the prior art.

¹⁰ Vol. B, p. 795

The Separator Patent.

This patent¹ relates to a means for separating the two different syrups that are thrown off by centrifugal force during the purging and washing operations in a centrifugal machine, during the refining of sugar.

The patent relied on for anticipation was Holland 703,728² which was not cited in the Patent Office during the prosecution of the Separator patent. The appellate court unanimously held Holland "as complete an anticipation of claims 10 and 12 as can be imagined." (Vol. E, p. 175.)

There is no question for this court to review in connection with the Separator patent except the fact of sufficiency of Holland's specification to inform a person skilled in the art how to make and use his invention. Even if this court was disposed to review this decision on a fact question, there is not the slightest reason to suppose this court would find error. Each point recited by petitioner in the appellate court was considered individually in the opinion and, without hesitation, was rejected. In plain words the Separator patent was held invalid over a "pat" reference, in a clearly reasoned decision founded on sound and well established legal principles. It calls for no review on any of the grounds commonly required by this court in support of a writ of certiorari.

REASONS OFFERED BY PETITIONER FOR GRANTING THE WRIT.

I.

Petitioner's first reason is primarily, that the Appellate Court and District Court decisions are in conflict and secondarily, that for practical considerations suit can not be brought in another circuit for a second adjudication.

¹ Vol. B, p. 693

² Vol. D, p. 650; Vol. B, p. 803

1. The mere reversal of a district court decision and the holding of the patents in suit invalid or not infringed do not afford adequate grounds for grant of the writ.

2. The decision does not involve any question of general or public interest; and the inability¹ to sue in another circuit is not due to concentration of the industry in the second circuit nor to the concentration of sugar refineries and factories there. Hence *Exhibit Supply Co. v. Ace Patents*, 315 U. S. 126 and like decisions, wherein patents were held valid and infringed by the Appellate Court or the industry was concentrated in one circuit and the public was to be saddled with a monopoly, do not apply to this case.

II.

Petitioner's second reason raises an old question as to the effect to be given to a reference patent (Carlson). Carlson's patent issued on an application filed prior to the application for the control patent in suit and prior to the earliest date asserted for the invention of the control patent, but Carlson's application was copending with that of the Control patent.

This question has been settled uniformly among the circuits and by this court in *Detrola v. Hazeltine*, 313 U. S. 259. It is now universally held that a patent in suit must disclose invention over a prior patent whose application was prior to but copending with the patent in suit. The patent issued on the prior copending application is "prior art"; and patents issued on applications copending with that of the patent in suit may be combined with other patents if only mechanical skill is involved, to show lack of invention of the patent in suit. The point was decided or such combinations were made or both, in the following cases.

¹ Petitioner's citations to the record do not establish that as a fact.

- Detrola Radio Corp. v. Hazeltine Corp.*, 313 U. S. 259, 85 L. Ed. 1319;
Hazeltine Corp. v. Abrams, 79 F. (2d) 329 (CCA 2);
Penmac v. Esterbrook, 108 F. (2d) 695, 696 (CCA 2);
Denaro v. Md. Baking Co., 50 F. (2d) 1074 (CCA 4), affg. 40 F. (2d) 513, 515-6;
Lemley v. Dobson-Evans, 243 Fed. 391 (CCA 6);
Ottinger v. Ferro Mfg. Co., 59 F. (2d) 640, 643 (CCA 6);
Curtis Co. v. Master Metal Co., 125 F. (2d) 690 (CCA 7);
Gasifier Co. v. G. M. Corp., 138 F. (2d) 197, 200 (CCA 8);
Electrol Inc. v. Merrell & Co., 39 F. (2d) 873, 877 (CCA 8);
In re Minn. Mining Co. v. Coe, 100 F. (2d) 429 (CCA DC);
Dyer v. Coe, 125 F. (2d) 192, 196 (CCA DC);
In re Youker, 77 F. (2d) 624 (CCPA);
Ex parte Bullova & Ratish, 56 U. S. P. Q. 421 (Pat. Off. B. of A.).

III.

The third and sixth reasons of petitioner allege that the Court of Appeals "changed" the claims by limiting them to what might be considered the invention, if there was any.

Such limitation is asserted to have been a departure from accepted legal principles and to have involved decisions on federal questions in conflict with applicable decisions of this court.

The principles applied by the Court of Appeals were the same principles as this court established more than half a century ago, in dealing with patent infringement

questions. This court has repeatedly limited claims to the means disclosed in the patent, in order to avoid the prior art, as was done by the appellate court in this case.

Pope v. Gormully, 144 U. S. 248, 253; 36 L. Ed. 423, 425;

Boyd v. Janesville, 158 U. S. 260; 39 L. Ed. 973;
Office Spec. Co. v. Fenton, 174 U. S. 492, 498; 43 L. Ed. 1058, 1060;

Kokomo Fence Co. v. Kitselman, 189 U. S. 8, 23, 47 L. Ed. 689, 696;

Singer Mfg. Co. v. Cramer, 192 U. S. 265; 48 L. Ed. 437, 447;

Computing Scale Co. v. Automatic Scale Co., 204 U. S. 609, 622; 51 L. Ed. 645, 652.

The same principles have been followed by the courts below in cases too numerous to cite. Typical examples are in the courts opinion (Rec. Vol. E. p. 173).

The assertion that the limitations went beyond any "fair" construction of the claims, involves the assumption that limiting claims of the Control and Brake patents to the means therein disclosed, *for the reasons given by the court*, was unfair. Such an assumption is highly argumentative; and a review of the decision on that basis would involve purely fact matters.

Clearly the Court of Appeals neither departed from the accepted course of judicial proceedings nor decided any new question of federal law nor any federal question in any way conflicting with this court's decisions.

Basically petitioner's complaint against the Appellate Court's decision is that it did not repeat the errors made by the District Court in deciding the case. That court ignored the prior art when considering infringement. The scope accorded the claims for the purpose of infringement was never measured against the prior art.

IV.

Petitioner's fourth reason deals with claim 8 of the Water Cooled Brake patent against which there are concurrent decisions below as to invalidity; and his fifth reason deals with the Separator patent, as to which review would involve only reconsideration of the fact of operability of the reference patent (Holland) over which the Separator was held invalid.

The reasons are plainly inadequate to warrant granting the writ.

In view of the foregoing, it is respectfully submitted that the petition should be denied.

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May 31, 1945.

